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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,589	09/26/2001	Wang Guofang	TOYAM76.001AUS	3546

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,589

Applicant(s)

GUOFANG ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. This Office action is in response to applicants' amendment received August 07, 2003 (Paper No: 9), which amends the specification, the abstract and claim 1, cancels claims 2-7 and adds claims 8-14.

Claims 1 and 8-14 are pending.

2. The amendment to the specification is supported by the compound represented by formula (17) as shown on page 13.

3. Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The application as originally filed provides insufficient support for the negative limitation set forth in the proviso added to claim 1 in Paper No. 9. While the compounds being excluded by the proviso are within the scope of generic formula (1) as originally disclosed, the application as originally filed did not specifically mention 2,7-naphthylene as a possibility for Y² and gave no specific examples of compounds in which Y¹ represents a phenylene group and Y² represents 1,7-naphthylene. The application as originally filed does not provide support for excluding these compounds. The mere absence of a positive recitation is not basis for an exclusion.

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Claim 8 is included in this rejection subject to interpretation of the claim limitations. If claim 8 is limiting Y² to any condensed ring arylene group other than 2,7-naphthylene, the claim is not supported by the original disclosure. However, if claim 8 is limiting Y² to the three specific possibilities recited after the second occurrence of Y², then the claim is supported by the original disclosure.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if claim 8 is limiting Y² to any condensed ring arylene group other than 2,7-naphthylene, or if claim 8 is limiting Y² to the three specific possibilities recited after the second occurrence of Y².

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Selby et al. in *Organic Letters* Vol. 1, No. 13, pp. 2053-2055 (published on Web 11/03/1999).

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Selby et al. disclose cyclic tertiary amine compounds represented by formula (1) as defined in present claims 9 and 13 wherein each A represents an aryl group, Y¹ represents an arylene group and Y² represents a condensed ring arylene group.

The only positive limitation set forth in the present claims regarding the device of claims 9-12 and the electroluminescent material of claims 13-14 is the compound represented by present formula (1).

7. Applicants' arguments filed August 07, 2003 have been fully considered but they are not persuasive.

With respect to claims 1 and 8, the examiner agrees that the prior art does not disclose or suggest a compound represented by formula (1) as defined in amended claim 1, with claim 8 dependent therefrom. However, the proviso recited in claim 1 is not supported by the original disclosure. (Claim 8 would be allowable if rewritten in independent form to clearly limit Y² to 1,4-naphthylene, fluoren-1,4-diyl or anthracen-1,4-diyl.)

With respect to claims 9-14, the only explicitly recited component of the claimed device and the claimed electroluminescent material is the compound represented by formula (1) as defined in claims 9 and 13, and Selby et al. anticipate a compound represented by formula (1) as defined in claims 9 and 13. (Claims 9-12 would be allowable if amended by inserting --comprising a pair of electrodes and a layer-- after "device" in line 1 of claim 9.)

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8. Miscellaneous:

In the last line of claim 1, "naphtylene" should read --naphthylene--.

In the last line of claim 8, "naphtylene" should read --naphthylene-- and "anthracen" should read --anthracen--.

In the first line of claim 14 "the" (first occurrence) should read --The--.

9. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for Art Unit 1774 is (703) 872-9306 for all official faxes. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (703) 872-9041.)

MRY
10/07/03



MARIE YAMNITZKY
PRIMARY EXAMINER

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